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10/590,124	04/20/2007	Klaus Kulper	101769-370 KGB	4140
27384	7590	03/29/2010	EXAMINER	
Briscoe, Kurt G. Norris McLaughlin & Marcus, PA 875 Third Avenue, 8th Floor New York, NY 10022			HUANG, CHENG YUAN	
			ART UNIT	PAPER NUMBER
			1794	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,124

**Applicant(s)**

KULPER ET AL.

**Examiner**

CHENG HUANG

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of in the reply filed on is acknowledged. Applicant's election with traverse of Group 1, claims 1-8 in the reply filed on 09 December 2009 is acknowledged. The traversal is on the ground(s) that the previous Office Action did not establish an undue search burden of the claims as specified by MPEP 803. This is not found persuasive because the instant application is a national stage entry filed under 35 U.S.C. 371 and is therefore not subject to US restriction practice but rather subject to lack of unity practice, see MPEP 1893.03(d). It is noted that undue search burden is not a criterion in lack of unity analysis. The test is whether or not special technical features can be established. It is noted that inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features as set forth in paragraph 2 of the previous Office Action.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 09 December 2009.

***Claim Objections***

3. Claim 1 is objected to because of the following informalities: "A abrasion-resistant..." should be corrected to "An abrasion-resistant...". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 6 recites the phrase "the optional layer B" which makes the scope of the claim unclear given that in claim 2, on which claim 6 depends, layer B is not optional but required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1, 3-5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCoste, Jr. et al. (U.S. Patent No. 4,705,715) in view of Boettcher (DE 10107569).
10. Regarding claims 1 and 4, DeCoste, Jr. et al. teaches a tape (See Title) comprising a backing with a first outer layer A (scrim 12, col. 4, lines 28-29), which is connected to a second layer C (foam 14, col. 4, lines 27-28) over the entire area of outer layer A (See Figs. 1 and 2), the outer layer A being composed of a scrim (scrim 12, col. 4, lines 28-29), and the layer C being composed of an open but stable three-dimensional structure (foam 14, col. 4, lines 27-28). The scrim of DeCoste, Jr. et al. is considered an "outer" layer since it is outer to at least one layer (e.g., adhesive layer 18, col. 4, line 36, Fig. 2).
11. DeCoste, Jr. et al. fails to teach wherein layer C is composed of a textile or basis weight.
12. However, Boettcher teaches a tape (See Title) wherein preferred examples disclose layer C as having a basis weight of 220 g/m<sup>2</sup> or 350 g/m<sup>2</sup> (fibrous mesh surface 2), (Abstract, line 2, See Tables on pages 3 and 4, lines 21 and 10 of original copy of DE 1017569), which falls within the claimed ranges of 100 to 500 g/m<sup>2</sup>, and is understood to be an open but stable three-dimensional nonwoven structure given that the fibrous mesh surface is an open fabric comprising fibers interlocking together and creating an open but stable three-dimensional structure.
13. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the nonwoven textile structure as layer C of DeCoste Jr. et al. for abrasion resistance and strength (Boettcher, paragraph [0008]).

14. While there is no disclosure that the tape of DeCoste, Jr. et al. as modified by Boettcher is an abrasion-resistant and noise-suppressing tape for bandaging cable harnesses as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

15. It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. an abrasion-resistant and noise-suppressing tape for bandaging cable harnesses, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art tape and further that the prior art structure which is identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

16. Regarding claim 3, while DeCoste, Jr. et al. as modified by Boettcher does not explicitly disclose the claimed limitation of abrasion resistance of the backing, the claimed values are inherent in the backing of DeCoste, Jr. et al. as modified by Boettcher since the prior art teaches materials identical (DeCoste, Jr. et al., polyethylene or polypropylene, col. 4, lines 42-44) to

those of the presently claimed invention (DeCoste, Jr. et al., polyolefins, paragraph [0048], Applicant's US-PGPUG).

17. Regarding claim 5, DeCoste, Jr. et al. as modified by Boettcher teaches wherein a foam layer has a thickness of 8 mils, or 0.203 mm (DeCoste, Jr. et al., col. 4, lines 39-41), which falls within the claimed range of 0.2 to 3 mm.

18. Regarding claim 8, DeCoste, Jr. et al. as modified by Boettcher teaches wherein the backing is coated at least on one side with a self-adhesive compound (DeCoste, Jr. et al., adhesive layer 18, col. 4, line 52, Fig. 2) and the self-adhesive compound is a rubber adhesive (DeCoste, Jr. et al., col. 3, lines 46-48).

19. Claims 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCoste, Jr. et al. (U.S. Patent No. 4,705,715).

20. DeCoste, Jr. as modified by Boettcher is relied upon as disclosed above.

21. Regarding claim 2, while DeCoste, Jr. et al. as modified by Boettcher fails to explicitly disclose a second outer layer, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second outer layer A being composed of a woven cloth web on an open side of layer C for easy tearability in the cross direction (DeCoste, Jr. et al., col. 3, lines 56-58). The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second outer layer being composed of woven fabric would have achieved expected results such as easy tearability in the cross direction. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960).

22. Regarding claim 6, the claimed limitation is a process limitation. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

23. Therefore, absent evidence of criticality regarding the presently claimed process and given that DeCoste, Jr. et al. as modified by Boettcher meets the requirements of the claimed tape, DeCoste, Jr. et al. as modified by Boettcher clearly meets the requirements of present claims.

24. Regarding claim 7, DeCoste, Jr. et al. as modified by Boettcher teaches wherein layer C comprises wear- resistant polymers (DeCoste, Jr. et al., polyethylene or polypropylene, col. 4, lines 42-44). It is understood that layers A and B of the tape of DeCoste, Jr. et al. as modified by Boettcher comprise wear-resistant polymers given that any known web materials may be used (DeCoste, Jr. et al., col. 4, lines 47-50), including natural or synthetic fibers (DeCoste, Jr. et al., col. 4, lines 49-51), which are intrinsically wear-resistant.



***Response to Arguments***

25. Applicant's' arguments filed 09 December 2009 have been fully considered but they are not persuasive.
26. Applicants' amended claim 1 to replace "porous sheetlike structure or of a foam or of a foamed sheet" with "textile having an open but stable three-dimensional structure" and amended claims 6 and 7 to depend from claim 2 instead of claim 1.
27. Applicants argue that DeCoste discloses a single layer of A and C.
28. However, there is nothing in the claims that require the recited layers to be separate, only that first outer layer A is connected to a second layer C which is clearly seen in Figs. 1 and 2 of DeCoste.
29. Applicants argue that Boettcher does not teach layer A as presently claimed. However, Boettcher is now only used as a secondary reference against the present claims. Note that while Boettcher does not disclose all the features of the present claimed invention, Boettcher is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the basis weight of a three-dimensional nonwoven structure, and in combination with the primary reference, discloses the presently claimed invention.

***Conclusion***

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

31. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHENG YUAN HUANG** whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1794

March 22, 2010

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794